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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID N. BROTHERSTON

Appeal 2009-015189
Application 09/682,583
Technology Center 3600

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 (2002) of the rejection of claims 1-25 which are all the claims pending in the application and have been twice rejected. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is directed a network of computers providing products and services to passengers and crew on a transport vehicle such as an aircraft (Spec. [0005]). Claim 8, reproduced below, is representative of the subject matter on appeal.

8. A system for fulfilling service orders on a transport vehicle, the system comprising an onboard computer transported with the vehicle and connections with electronic devices operated by vehicle personnel or passengers, the onboard computer including software, which when operated on the onboard computer and electronic devices causes the onboard computer to perform tasks comprising accepting service orders entered via the electronic devices by vehicle personnel or passengers and making the service orders accessible to vehicle personnel wherein the electronic devices include passenger supplied personal information processing apparatus carried on by passengers.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Berry	US 5,311,302	May 10, 1994
Ross	US 5,444,444	Aug. 22, 1995
Parks	US 5,526,481	Jun. 11, 1996
Bravman	US 5,646,389	Jul. 8, 1997
Bezos	US 5,727,163	Mar. 10, 1998
Camaisa	US 5,845,263	Dec. 1, 1998
Rondeau	US 5,850,433	Dec. 15, 1998
Tracy	US 5,979,757	Nov. 9, 1999
Hall	US 6,026,375	Feb. 15, 2000
Weber	US 6,122,620	Sep. 19, 2000
Leuca	US 6,201,797 B1	Mar. 13, 2001
Roden	US 6,249,774 B1	Jun. 19, 2001

The following rejections are before us for review¹:

1. Claims 1-3 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berry and Ross.
2. Claims 4 and 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Ross, and Camaisa.
3. Claims 5 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Ross, and Roden.

¹ The Appellant seeks review of whether the new grounds of rejection applied in the most recent Office Action is in compliance with compact prosecution (Br. 15-17). This objection is not subject matter reviewable by the Board of Patent Appeals and Interferences but rather petitionable subject matter. See M.P.E.P 1002 and 1201.

4. Claim 6 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Ross, and Bravman.
5. Claims 25 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Ross, and Tracy.
6. Claims 7 and 12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berry and Rondeau.
7. Claims 10-11 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Rondeau, and Tracy.
8. Claims 13 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Ross, and Rondeau.
9. Claims 14 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Rondeau, Ross, and Camaisa and/or Hall.
10. Claims 15 is rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Rondeau, Ross, and Leuca.
11. Claims 8-9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berry and Bezos.
12. Claims 16-24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berry, Ross, Camaisa, Rondeau, Roden, and Weber.

THE ISSUES

With regards to claim 1 and its dependent claims the issue turns on whether Ross discloses “acquiring information to determine the available services provided on the transport vehicle”.

With regards to claim 7 the issue turns on whether Rondeau discloses “providing menu options adapted for specific customer preferences that vary

based on pre-selected products and services and historical preference”.

Claims 10-24 turn on a similar issue.

With regards to claim 8 the issue turns on whether it would have been obvious to modify Berry and Bezos as asserted in the rejection to meet the claim limitations. Claim 9 turns on the same issue.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Ross at Col. 3:65-4:22 does not disclose “acquiring information to determine the available services provided on the transport vehicle”. While Ross at this section does disclose receiving information such as the route, package identification, recipient name and address, phone numbers and the like it is not specifically disclosed that there is “acquiring information to determine the available services provided on the transport vehicle”.

FF2. Rondeau in the Abstract does not disclose “providing menu options adapted for specific customer preferences that vary based on pre-selected products and services and historical preference”. While Rondeau in the Abstract does disclose the profiles to include historical directory usage this does not disclose customer preferences based on both pre-selected products and services and historical preference.

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF3. Berry has disclosed an entertainment and data management system for a passenger vehicle including individual seat interactive video terminals (Title).

FF4. Berry discloses that a terminal can be provided in the front of a passenger seat in an aircraft or other vehicle. Operations may include the selection of an individual video tape player, ordering of food and drinks and catalog merchandise, and the placing of telephone calls. A credit card reader may be provided. (Abstract). Berry in Figure 2 shows a portion of such a device.

FF5. Bezos has disclosed a method for placing an order charged to a credit card over an unsecured network. The customer enters only a subset of the credit card account number to which the order is to be charged and the order is transmitted over the Internet or other network to a merchant location. In a subsequent telephone call the customer enters the complete credit card number preferably by a touch tone phone. Using the portions of the credit card number provided identifies the order previously placed and finalizes it. (Abstract). Figures 1 and 3 show a portion of the system and method.

FF6. Bezos discloses that a desktop computer or personal digital assistant (PDA) can be used in the system (Col. 4:59-64).

ANALYSIS

Claims 1-6 and 25

The Appellant argues that the rejection of claim 1 is improper because the cited prior art fails to disclose elements of claim limitation “c” which require the external computer be operable to perform tasks including “ i)

acquiring information to determine the available services provided on the transport vehicle” (Br. 17).

In contrast, the Examiner has determined that the cited claim limitation above from claim 1 is shown by Ross at Col. 3:65-4:22 (Ans. 5). The Examiner has also determined that the cited claim limitation uses the phrase is “operably performed by the software on the external computer” and therefore only a statement of intended use (Ans. 14).

We agree with the Appellant. First, the claim limitation does refer to the software “being operable on the external computer” but when read with the remainder of the claim it is also required that the software is “for causing the external computer to perform tasks including: i) acquiring information to determine the available services provided on the transport vehicle” which is not simply intended use but rather a limitation to the claim. Ross at Col. 3:65-4:22 does not disclose this claim limitation (FF1) and the rejection of claim 1 and its dependent claims is therefore not sustained.

Claims 7 and 10-24

The Appellant argues that the rejection of claim 7 is improper because the cited prior art fails to disclose elements of the claim limitation for “providing menu options adapted for specific customer preferences that vary based on pre-selected products and services and historical preference” (Br. 29).

In contrast, the Examiner has determined that the cited claim limitation above from claim 7 is shown by Rondeau in the Abstract (Ans. 8). The Examiner has also determined that the cited claim limitation uses the

phrase is “adapted for” and is therefore only a statement of intended use (Ans. 17).

We agree with the Appellant. First, the claim limitation does use the phrase “adapted for” but when read with the remainder of the claim requires the menu options to be provided in a specific way with the “customer preferences that vary based on pre-selected products and services and historical preference” which is not a mere statement of intended use in this specific claim. Rondeau in the Abstract fails to disclose this cited claim limitation (FF2) and the rejection of claim 7 and its dependent claims is therefore not sustained. Claim 16 contains a similar limitation and the Examiner refers to the rejection of claim 7 in the Answer as providing details of this claim limitation (Ans. 20). For the same reasons given above the rejection of claim 16 and its dependent claims not sustained as well.

Claims 8-9

The Appellant argues that the rejection 8 is improper (Br. 34-38, Reply Br. 14-16). The Appellant describes how the device of Berry and Bezos operate and assert that modification with Bezos would be redundant because Berry already includes a card reader and that there is no motivation to implement the system with an unsecured network as taught by Bezos (Br. 34-36). The Appellant argues that it would not have been predictable based on the cited art to modify Berry to include the teachings of Bezos (Reply Br. 15).

In contrast, the Examiner has determined that Bezos teaches using a laptop or PDA to place an order and that it would have been obvious to

modify Berry to include this feature to incorporate a portable device as an alternative to a fixed device (Ans. 10).

We agree with the Appellant. In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) the Supreme Court at 418 noted that in an obviousness analysis that “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”. Here, Bezos is directed to being used in a system with an unsecured network (FF5) and it is unclear that such an unsecured network would be desirable in the vehicle. While Bezos does show the use of a PDA device to place an order (FF6) it is also directed to a complex system involving placing a later telephone call for instance to the system and providing a credit card number (FF5). In this case, the rejection of record lacks articulated reasoning with rational underpinnings to use the specific feature of the PDA placed order of Bezos into the system of Bezos without impermissible hindsight. For this reason the rejection of claim 8 and its dependent claim 9 is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting the claims as listed in all the rejections made under 35 U.S.C. § 103(a) which are listed in the Rejections section above.

DECISION

The Examiner’s rejection of claims 1-25 is reversed.

REVERSED

MP